

## REMARKS

This Application has been carefully reviewed in light of the Office Action mailed January 11, 2007. At the time of the Office Action mailed, Claims 33-44, 46-56, 58-70, 72 and 73 were pending in this Application. Claims 33-39 and 46-53 were previously withdrawn from consideration by the Examiner. Claims 40-44, 62, 68-70 and 73 have been amended to further define various features of Applicant's invention. Claims 45, 57 and 71 were previously cancelled without prejudice or disclaimer. Claims 54 and 64 have been cancelled without prejudice or disclaimer. Applicant respectfully requests reconsideration and favorable action in this case.

### **Rejections under 35 U.S.C. § 112**

Claims 40-44, 54-56, 58-61 and 70 were rejected by the Examiner under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Applicant amends Claims 40 to include particles of a size between "about 350 $\mu$  and 2200 $\mu$ " to overcome this rejection. However, Applicant maintains that the term "about" as recited applies to both size ranges. This interpretation is consistent with the particle size descriptions used throughout the specification. See, e.g. paragraph [0025], as published.

Claims 62-69 and 72-73 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant amends Claims 62 and 73 to overcome these rejections.

Applicant respectfully requests reconsideration and full allowance of Claims 40, 62 and 73, as amended, and Claims 41-44, 54-56, 58-61, 63, 65-69, 70 and 72 which depend therefrom.

### **Rejections under 35 U.S.C. § 102**

Claims 40, 44, 54-56, 58-59, 61-65, 68-70 and 73 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,258,028 issued to Ersek et al. ("Ersek"). Applicant

respectfully traverses and submits the cited art does not teach all of the elements of the claimed embodiment of the invention.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims. Independent claims 40 and 62 each recite an injectable hard tissue implant composition that includes, among other elements, a “flowable matrix comprising polymethylmethacrylate”. In contrast Ersek is direct to a implant for plastic surgery/reconstruction of soft tissue (see abstract, Col. 1, lines 11-14; Col. 4, lines 22-44) that uses a “physiologic vehicle” (see Col. 2, lines 55-68) to deliver micro particles (see Col. 4, lines 21-26).

The Office Action contends that the physiologic vehicle of Ersek is equivalent to the claimed flowable matrix. Applicant traverses. As amended the matrix includes polymethylmethacrylate, a bone cement. Ersek teaches that the physiologic vehicle will “cause minimal tissue reaction and are removed or metabolized without cytotoxicity...” Col. 2, lines 52-54. Ersek does not teach specifically teach polymethylmethacrylate as a physiologic vehicle and, additional, one of skill in the art would not select a settable bone cement as a delivery vehicle for use as a particle delivery vehicle in a soft tissue reconstruction.

For at least these reasons, Applicant submit that Ersek does not anticipate claims 40, 62 or Claims 44, 55-56, 58-59, 61, 63, 65, 68-70 and 73 which depend therefrom.

### **Rejections under 35 U.S.C. §103**

In the alternative to the above rejection, Claims 40-44, 54-56, 58-61, 63, 66, 67 and 72 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ersek. Applicant respectfully

traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As discussed above, Ersek fails to teach all claimed limitations and therefore, cannot render obvious the claimed invention. Applicants request reconsideration, withdrawal of the rejections under section §103(a) and full allowance of Claims 40-44, 54-56, 58-61, 63, 66, 67 and 72.

### **Comments Regarding Remarks**

The Remarks section of the Office Action contends that “Not only is a specific concentration [of particles] not claimed, a preferred concentration is not even disclosed in the specification.” Page 2. To this assertion, Applicant kindly refers the Examiner to Claims 67 and 72 (both claiming specific concentration of radiopaque tracer particles) as well as paragraphs 36 and 37 of the specification, as published (describing two Example embodiments including amount/concentration of tracer particles).

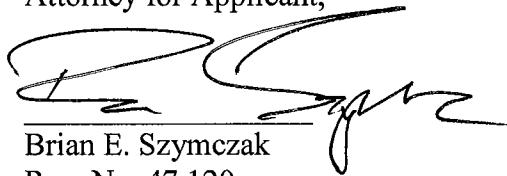
### CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.391.3961.

Respectfully submitted  
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